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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,568	10/11/2001	George Friedman	EMPIR-02SAUS	7486

22494 7590 10/28/2003

DALY, CROWLEY & MOFFORD, LLP  
SUITE 101  
275 TURNPIKE STREET  
CANTON, MA 02021-2310

EXAMINER

SUAREZ, FELIX E

ART UNIT	PAPER NUMBER
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2857

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/975,568

Applicant(s)

FRIEDMAN ET AL.

Examiner

Felix E Suarez

Art Unit

2857

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being unpatentable over Hartmann et al. (U.S. Patent No. 6,505,342).

With respect to claims 1 and 6, Hartmann et al. (hereafter Hartmann) teaches a method (or a computer program product) of correctly ordering test code for testing software components comprising the steps of:

generating test code for testing a software component (see col. 16, lines 59-67 and col. 17, lines 27-46);

utilizing a software diagramming tool to provide at least one sequence diagram of said software component (see col. 15 lines, 4-11 and col. 29, lines 29-53); and

ordering said test code in accordance with said sequence diagram (see col. 5, lines 1-15 and col. 21, lines 20-48).

With respect to claims 2 and 7, Hartmann further teaches said software component is selected from the group comprising COM, DCOM, COM+, Corba, and EJB (see col. 32, lines 21-38).

With respect to claims 3 and 8, Hartmann further teaches said step of generating test code comprises the step of determining at least one method of said software component (see col. 8 line 42 to col. 9 line 17).

With respect to claims 4 and 9, Hartmann further teaches at least one method to determine the type of data required to test said at least one method (see col. 6, lines 5-17 and col. 18, lines 19-51).

With respect to claims 5 and 10, Hartmann further at least one method to determine parameters to be passed to said at least one method in order to test said at least one method of said software component (see col. 14, lines 18-29).

### ***Response to Arguments***

2. This action is responsive to papers filled 07/18/03.

3. Applicant's arguments filled 07/18/03 have been fully considered but they are not persuasive respect to claims 1-10. The Examiner has thoroughly reviewed applicant arguments, but believes the cited references to reasonably and properly meet the claimed limitations.

The invention is a software program designed to provide correctly ordered test code in order to effectively test software components and has a practical application.

Applicant claims a method or a computer program for generating test code for testing a software component. The Examiner rejects claims 1-10, in view of the newly discovered reference to Hartmann et al. (U.S. Patent No. 6,505,342).

### ***Conclusion***

#### ***Prior Art***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Abe [U.S. Patent No 6,493,425] describes a method for testing a network element.

Hoshi et al. [U.S. Patent No 6,266,447] describes a coding apparatus.

Miloushev et al. [U.S. Patent No 6,226,692] describes a method for designing and constructing software components.

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Underwood [U.S. Patent No. 6,609,128] describes text phrases subsequently retrieved by selecting a corresponding code of a table.

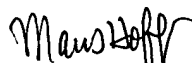
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix Suarez, whose telephone number is (703) 308-4926. The examiner can normally be reached on weekdays from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on (703) 308-1677. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7382 for regular communications and (703) 308-7382 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

October 1, 2003

F.S.

  
MARC S. HOFF  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800